



DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No. PTO-P-2017-0011]

RIN 0651-AD21

Date of Receipt of Electronic Submissions of Patent Correspondence

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Final rule.

SUMMARY: The United States Patent and Trademark Office (USPTO or Office) is amending the patent rules of practice to provide that the receipt date of correspondence officially submitted electronically by way of the USPTO patent electronic filing system is the date in the Eastern time zone of the United States (Eastern Time) when the USPTO received the correspondence rather than the date on which the correspondence is received at the correspondence address in Alexandria, Virginia. This change is necessary because the USPTO is expecting to provide servers for receiving electronic submissions in locations that are separate from the USPTO headquarters in Alexandria, Virginia. This change will ensure consistency and predictability with respect to correspondence receipt dates, as the date of receipt accorded to correspondence submitted electronically will not depend on the location of USPTO servers. The USPTO is also amending the patent rules of practice to make other clarifying changes regarding the receipt of electronic submissions, including providing a definition for Eastern Time. These changes harmonize the patent rules with the trademark rules and provide clarity regarding the date of receipt of electronic submissions.

DATES: This rule is effective on **[INSERT DATE 30 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER]**.

FOR FURTHER INFORMATION CONTACT: For patent-related inquiries, please contact Mark O. Polutta, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-7709; or Kristie M. Kindred, Legal Advisor, Office of Patent Legal Administration, at 571-272-9016; or you can send inquiries to patentpractice@uspto.gov.

SUPPLEMENTARY INFORMATION: The USPTO's servers that receive electronic submissions are currently located in Alexandria, Virginia. However, to enhance resiliency, the USPTO is in the process of providing servers in Manassas, Virginia, and in the future, may provide servers outside of the Eastern time zone. Once the USPTO begins receiving electronically submitted patent correspondence at locations other than Alexandria, Virginia, the rule language that defines the receipt date as the date the correspondence is received at the correspondence address in Alexandria, Virginia, would be inapplicable. Thus, the USPTO is revising 37 CFR 1.6(a)(4) to specify that the receipt date of correspondence that is officially submitted electronically by way of the USPTO patent electronic filing system is the date in Eastern Time when the USPTO received the correspondence, regardless of the physical location of the USPTO server that receives the correspondence. Other clarifying changes regarding the receipt date of electronic submissions, including providing a definition for Eastern Time, are also being made.

In addition, the changes align the patent rules with the Legal Framework for the Patent Electronic System (October 23, 2019) (Legal Framework), available at www.uspto.gov/patents/apply/filing-online/legal-framework-efs-web and incorporated in the Manual of Patent Examining Procedure (9th ed., Rev. 10.2019) (MPEP) section 502.05, subsection I. The Legal Framework indicates that the time and date of receipt of an application filed via the USPTO patent electronic filing system is the local time and date (Eastern Time) at the USPTO headquarters in Alexandria, Virginia, when the USPTO received the submission. The date of receipt is recorded after the user clicks the "Submit" button on the "Confirm and

Submit” screen. This is the date shown on the Electronic Acknowledgement Receipt. Similarly, follow-on documents filed in a patent application after the initial filing of the application are also accorded the date (Eastern Time) when the document is received at the USPTO as the date of receipt under existing practice. See MPEP section 502.05, subsection I.C.

With respect to patent correspondence, any reference to the USPTO patent electronic filing system (EFS) in this final rule (including in 37 CFR part 1) includes EFS-Web and Patent Center. Patent Center is a new tool for the electronic filing and management of patent applications. Patent Center is available for all users. Patent Center has replaced the public Patent Application Information Retrieval (PAIR) system and, once fully developed, will replace EFS-Web and the private PAIR system as well. Users of Patent Center are required to abide by the Legal Framework to the extent applicable and the Patent Electronic System Subscriber Agreement. See the Patent Center information webpage available at www.uspto.gov/patents/apply/patent-center. In the future, as Patent Center gets closer to full development, the Legal Framework will be revised to expressly refer to and more specifically cover electronic submissions via Patent Center. The rules use generic terminology to refer to the system for electronically filing patent applications and patent correspondence in order to accommodate any name changes to the system that may occur in the future.

The rules of practice in trademark cases already provide that filing dates of electronic submissions are based on Eastern Time. See 37 CFR 2.195(a). Therefore, it is unnecessary to amend the trademark rules of practice.

Discussion of Specific Rules

The following is a discussion of the amendments to 37 CFR part 1.

Section 1.1: Section 1.1(a) is amended to clarify the appropriate address information for patent-related correspondence. In particular, the clause “[e]xcept as provided in paragraphs (a)(3)(i) and (a)(3)(ii) of this section” is being changed to “[e]xcept for correspondence submitted via the USPTO patent electronic filing system in accordance with § 1.6(a)(4).” Further, the phrase “to specific areas within the Office as set out in paragraphs (a)(1) and (a)(3)(iii) of this section” is being replaced with “to specific areas within the Office as provided in this section.” Since the USPTO does not strictly require the provision of an address when patent-related correspondence is submitted via the USPTO patent electronic filing system, it is appropriate to exclude such correspondence from the address marking requirements of § 1.1(a). Applicants may continue to provide an address on correspondence submitted via the USPTO patent electronic filing system consistent with § 1.1(a), but it is not mandatory. The removal of references to specific paragraphs (a)(3)(i) and (ii) from the introductory text of paragraph (a) is a technical correction in view of the remaining language in this section.

Section 1.6: Section 1.6(a)(4) is amended to remove the reference to the physical location where correspondence must be received, and to provide that the receipt date of patent correspondence submitted using the USPTO patent electronic filing system is the date in Eastern Time when the correspondence is received in the USPTO. Specifically, the phrase “Correspondence submitted to the Office by way of the Office electronic filing system will be accorded a receipt date, which is the date the correspondence is received at the correspondence address for the Office set forth in § 1.1 when it was officially submitted” has been changed to “Correspondence officially submitted to the Office by way of the USPTO patent electronic filing system will be accorded a receipt date, which is the date in Eastern Time when the correspondence is received in the Office.” In view of the relocation of the servers, it is appropriate to eliminate the reference to the correspondence address set forth in § 1.1 in connection with the receipt date of correspondence

being filed electronically. Correspondence submitted via the USPTO patent electronic filing system will be accorded a receipt date based on the local time and date at the USPTO headquarters in Alexandria, Virginia, when the correspondence is received in the USPTO. Specifically, the USPTO patent electronic filing system will record the receipt date in Eastern Time after the user officially submits the correspondence by clicking the “Submit” button on the “Confirm and Submit” screen and the correspondence is fully, successfully, and officially received in the USPTO. Furthermore, the phrase “regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia” is being added to provide clarity in the rule. This is not a change in practice. See MPEP section 502.05, subsection I.C3.

One should note that the Legal Framework does not permit certain patent correspondence to be officially submitted via the USPTO patent electronic filing system. See MPEP section 502.05, subsection I.B2. Such correspondence will not be accorded a date of receipt or considered officially filed in the USPTO when submitted via the USPTO patent electronic filing system. For example, notices of appeal to a court, district court complaints, or other complaints or lawsuits involving the USPTO may not be filed via the USPTO patent electronic filing system. See MPEP section 1216 for instructions on how to properly serve and/or file documents seeking judicial review of a decision by the Patent Trial and Appeal Board.

Section 1.9: Section 1.9 is amended to add a new paragraph (o) to set forth a definition for Eastern Time. In particular, Eastern Time is defined as meaning Eastern Standard Time or Eastern Daylight Time in the United States, as appropriate.

Changes to standardize references to the USPTO patent electronic filing system: 37 CFR part 1 is amended to revise all references to “Office’s electronic filing system” and “Office electronic filing system” to “USPTO patent electronic filing system.”

Comments and Responses

The USPTO published a notice of proposed rulemaking on December 7, 2021, at 86 FR 69195, soliciting public comments on the proposed amendments to 37 CFR part 1 being adopted in this final rule. The USPTO received written input from three commenters on the proposed rule.

Summaries of the comments and the Office's responses to the written comments follow.

Comment 1: One commenter expressed support for the rule changes.

Response: The USPTO appreciates the feedback from the commenter.

Comment 2: One commenter questioned whether the new definition of filing in the Eastern time zone will have any effect on the use of a certificate of transmission based on the local time zone for patent filings.

Response: There is no change being made to certificate of mailing or transmission practice under 37 CFR 1.8. Applicants may still use a certificate of mailing or transmission in accordance with the provisions of 37 CFR 1.8 for the filing of patent correspondence in patent applications where permitted. One should note that the certificate of mailing or transmission practice under 37 CFR 1.8 is not applicable to the filing of new patent applications or other patent correspondence necessary for the purpose of obtaining an application filing date.

Comment 3: One commenter stated that the definition in the notice of proposed rulemaking of the "Office electronic filing system" as including EFS-Web and Patent Center was ambiguous since it was unclear whether it applies to other Office electronic filing systems in addition to EFS-Web and Patent Center.

Response: This final rule amends 37 CFR part 1 to replace all references to "Office electronic filing system" to "USPTO patent electronic filing system." The only electronic filing systems for filing new patent applications or correspondence in existing patent applications are EFS-Web and Patent Center. While other electronic systems exist, such as the Electronic Patent Assignment System for recording assignment documents or the Certified Copy Center for

ordering patent and trademark documents, these are not electronic filing systems encompassed by the phrase “Office electronic filing system” or “USPTO patent electronic filing system” as used in the notice of proposed rulemaking or in this final rule. These other electronic systems are not used for filing new patent applications or correspondence in existing patent applications.

While it is possible to indicate on the cover sheet for the assignment document that the document also serves as the inventor’s oath or declaration under 37 CFR 1.63, and the USPTO will then place a copy of the document in the application file, this is not a situation in which an applicant is filing correspondence directly into an existing application. The rules use generic terminology to refer to the electronic filing system because the system name(s) may change over time. As mentioned in this final rule, EFS-Web is being phased out and will be replaced by Patent Center.

Comment 4: One commenter stated that the notice of proposed rulemaking is inconsistent with 35 U.S.C. 111(a)(4) regarding filing dates for patent applications. The commenter noted that the statute does not state that the filing date is the date after the user clicks the “Submit” button on the “Confirm and Submit” screen, and the statute does not state that the filing date is the date shown on the Electronic Acknowledgement Receipt. The commenter also noted that the USPTO server may delay generating “the date shown on the Electronic Acknowledgement Receipt.” The commenter further stated that the filing date for an application should be the date a specification, with or without claims, is received by a USPTO server, which occurs prior to the USPTO server acknowledging receipt, and prior to the filer pressing the “Submit” button.

Response: As noted by the commenter, 35 U.S.C. 111(a)(4) provides that “[t]he filing date of an application shall be the date on which a specification, with or without claims, is received in the United States Patent and Trademark Office.” Similarly, 35 U.S.C. 111(b)(4) provides that “[t]he filing date of a provisional application shall be the date on which a specification, with or without claims, is received in the United States Patent and Trademark Office.” The regulations at 37 CFR 1.6 define what “received in the U.S. Patent and Trademark Office” in the statute means, and it is consistent with the statute. Contrary to the argument made by the commenter, it would be

inconsistent with the statute for the USPTO to accord a filing date to an application on the date it was sent or transmitted to the USPTO (except as permitted by 35 U.S.C. 21(a) and provided for in 37 CFR 1.10) rather than received in the USPTO, or the date an application was uploaded to a server without the user having completed the filing process. The Legal Framework sets forth what must occur in order for an electronic filing to be completed and for the submission to be accorded a receipt date. The filer must press the “Submit” button to actually file an application or document and complete the filing process. Users can upload documents and save submissions for later review and filing for up to 7 days in EFS-Web and for up to 14 days in Patent Center. Accordingly, until the filer actually clicks on the “Submit” button on the “Confirm and Submit” screen, the application or document has not been filed in the USPTO. The receipt date on the Electronic Acknowledgement Receipt reflects the date that the application or document was actually received in the USPTO. While there may be a delay in the sending of an Electronic Acknowledgement Receipt in some cases, that does not mean there has been a delay in recording the actual date of receipt.

Rulemaking Considerations

A. Administrative Procedure Act: The changes in this rulemaking involve rules of agency practice and procedure, and/or interpretive rules. See *Bachow Commc’ns Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); *Inova Alexandria Hosp. v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals are procedural where they do not change the substantive standard for reviewing claims); *Nat’l Org. of Veterans’ Advocates v. Sec’y of Veterans Affairs*, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive).

Accordingly, prior notice and opportunity for public comment for the changes in this rulemaking were not required pursuant to 5 U.S.C. 553(b) or (c), or any other law. See *Cooper Techs. Co. v.*

Dudas, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), do not require notice-and-comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice” (quoting 5 U.S.C. 553(b)(A))). However, the USPTO chose to seek public comment before implementing the rule to benefit from the public’s input.

B. Regulatory Flexibility Act: For the reasons set forth in this final rule, the Senior Counsel for Regulatory and Legislative Affairs, Office of General Law, of the USPTO has certified to the Chief Counsel for Advocacy of the Small Business Administration that the changes in this rule will not have a significant economic impact on a substantial number of small entities (see 5 U.S.C. 605(b)).

This rulemaking amends the rules of practice to provide that the receipt date of correspondence officially submitted electronically by way of the USPTO patent electronic filing system is the date in Eastern Time when the Office received the correspondence. The USPTO is also amending the patent rules of practice to make other clarifying changes regarding the receipt of electronic submissions. These changes are procedural in nature and do not result in a change in the burden imposed on any patent applicant, including a small entity.

For the reasons described above, the changes will not have a significant economic impact on a substantial number of small entities.

C. Executive Order 12866 (Regulatory Planning and Review): This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

D. Executive Order 13563 (Improving Regulation and Regulatory Review): The USPTO has complied with Executive Order 13563 (Jan. 18, 2011). Specifically, the USPTO has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector, and the public as a whole, and provided online access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across Government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

E. Executive Order 13132 (Federalism): This rulemaking does not contain policies with federalism implications sufficient to warrant the preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

F. Executive Order 13175 (Tribal Consultation): This rulemaking will not: (1) have substantial direct effects on one or more Indian tribes, (2) impose substantial direct compliance costs on Indian tribal governments, or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

G. Executive Order 13211 (Energy Effects): This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse

effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

H. Executive Order 12988 (Civil Justice Reform): This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

I. Executive Order 13045 (Protection of Children): This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

J. Executive Order 12630 (Taking of Private Property): This rulemaking will not affect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

K. Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.), the USPTO will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this rulemaking are not expected to result in an annual effect on the economy of \$100 million or more; a major increase in costs or prices; or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this rulemaking is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

L. Unfunded Mandates Reform Act of 1995: The changes set forth in this rulemaking do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of \$100 million (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of \$100 million (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

M. National Environmental Policy Act of 1969: This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 et seq.

N. National Technology Transfer and Advancement Act of 1995: The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions that involve the use of technical standards.

O. Paperwork Reduction Act of 1995: The Paperwork Reduction Act of 1995 requires that the USPTO consider the impact of paperwork and other information collection burdens imposed on the public. This rulemaking does not involve any new information collection requirements that are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.).

Notwithstanding any other provision of law, no person is required to respond to, nor shall a person be subject to a penalty for failure to comply with, a collection of information subject to

the requirements of the Paperwork Reduction Act unless that collection of information has a currently valid OMB control number.

List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Biologics, Courts, Freedom of information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

For the reasons set forth in the preamble, 37 CFR part 1 is amended as follows:

PART 1 – RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2), unless otherwise noted.

2. In 37 CFR part 1, remove “Office’s electronic filing system” and “Office electronic filing system” wherever they appear and add in their place “USPTO patent electronic filing system.”

3. Section 1.1 is amended by revising paragraph (a) introductory text to read as follows:

§ 1.1 Addresses for non-trademark correspondence with the United States Patent and Trademark Office.

(a) *In general.* Except for correspondence submitted via the U.S. Patent and Trademark Office (USPTO) patent electronic filing system in accordance with § 1.6(a)(4), all correspondence intended for the USPTO must be addressed to either “Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450” or to specific areas within the Office as provided in this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.

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4. Section 1.6 is amended by revising paragraph (a)(4) to read as follows:

§ 1.6 Receipt of correspondence.

(a) * * *

(4) Correspondence may be submitted using the USPTO patent electronic filing system only in accordance with the USPTO patent electronic filing system requirements. Correspondence officially submitted to the Office by way of the USPTO patent electronic filing system will be accorded a receipt date, which is the date in Eastern Time when the correspondence is received in the Office, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia.

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5. Section 1.9 is amended by:

- a. Adding paragraph (o); and
- b. Removing the parenthetical authority citation at the end of the section.

The revision reads as follows:

§ 1.9 Definitions.

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(o) *Eastern Time* as used in this chapter means Eastern Standard Time or Eastern Daylight Time in the United States, as appropriate.

Katherine K. Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

[FR Doc. 2022-24335 Filed: 11/16/2022 8:45 am; Publication Date: 11/17/2022]